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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re Patent Application Of:

Rolf Steiger : Group: 1774

Serial No.: 09/336,462 : Examiner: P. Schwartz

Filing Date: June 18, 1999 :

Title: RECORDING SHEETS FOR INK JET PRINTING :

-----: May 12, 2004

Mail Stop CPA  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

CONTINUED PROSECUTION APPLICATION (CPA)  
(37 C.F.R. § 1.53(d))

1. This is a request for the filing of a

  X   continuation

       divisional

continued prosecution application under 37 CFR § 1.53(d) of the above-identified prior nonprovisional application.

It is further requested that this continued prosecution application utilize the file jacket and contents of the prior application, including the specification, drawings, and oath or declaration from the prior application, to constitute this new application, and that the application number of the above-identified prior application be assigned for identification purposes. 37 CFR § 1.53(d)(2)(iv).

The prior application is assigned to ILFORD IMAGING SWITZERLAND GMBH, and an assignment document was recorded in the prior application.

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It is also requested that the above-identified application be expressly abandoned as of the filing date accorded this continued prosecution application. 37 CFR § 1.53(d)(2)(v).

## 2. Copendency With Prior Application

With respect to the above-identified non-provisional application, this continued prosecution application is being filed:

A. X before the earliest of the:

- termination of proceedings on the prior application (37 CFR § 1.53(d)(1)(ii)(C);
- payment of the Issue Fee thereon (37 CFR § 1.53(d)(1)(ii)(A)); or
- X   abandonment of the prior application (37 CFR § 1.53(d)(1)(ii)(A)); (subject to a Petition to Revive submitted simultaneous with this Submission)

OR

B.        after the payment of the Issue Fee -- A petition under § 1.313(b)(5) has been granted in the prior application. 37 CFR § 1.53(d)(1)(ii)(A).

The term for response or taking action in the prior application expired on February 12, 2004.

  X   An extension of time in the prior application is:

       filed concurrently in the prior application.

  X   has been filed on January 12, 2004; and with the Petition to Revive filed herewith.

## 3. No New Matter

This application discloses and claims only subject matter disclosed in the prior application. 37 CFR § 1.53(d)(2)(ii).

**4. Access to Prior Application**

Filing of this continued prosecution application is to be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. § 122, to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning, either in the prior application or any continuing application filed under the provisions of 37 CFR § 1.53(d), may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket. 37 CFR § 1.53(d)(6).

**5. 35 U.S.C. § 120 Statement**

Filing of this request is the specific reference required by 35 U.S.C. § 120 to every application assigned the application number identified in this request. No amendment in this application may delete this specific reference to any prior application. 37 CFR § 1.53(d)(7) and 1.78(a)(2).

**6. Foreign Priority Claim**

The above-identified prior application claimed priority benefit of European Patent application Serial No.: 98810556.5 filed June 18, 1998. This continued prosecution application claims the same priority benefits.

**7. Inventorship**

This continued prosecution application names as inventors:

  X   the same inventors named in the prior application on the date this continued prosecution application under 37 CFR § 1.53(d) is being filed.

       inventors fewer than all the inventors named in the prior application. Please DELETE the following name(s) as inventor(s):

**8. Preliminary Amendment**

Please enter the following Preliminary Amendment:

**PRELIMINARY AMENDMENT**

The present application is a continued prosecution application of Serial No. 09/336,462 filed June 18, 1999 (the "parent application").

In the Office Action dated August 12, 2003, the claims in the parent application were finally rejected. An Amendment After Final Rejection was filed on January 12, 2004.

The Examiner responded to the Amendment in an Advisory Action dated February 23, 2004 in which she maintained the rejections of the claims as obvious over Brugger et al (6,156,419) in view of Malhotra (5,589,277).

Applicants submit this Preliminary Amendment in advance of examination to overcome the Examiners rejections stated in the Office Action and Advisory Action of the parent application.

R E M A R K S

All claims pending, namely 1-3, 5, 8, 9 and 11-21 have been finally rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,156,419 to Brugger et al. in view of secondary references to Malhotra, Floegel, Uemura or Kasahara.

Common Inventor/Common Ownership

For applications filed on or after November 29, 1999, the rejections under 35 U.S.C. 103(a) can be overcome by showing that the subject matter of the Brugger et al. reference and the present invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. [MPEP 706.02(1)1 and 706/02(1)(2)].

The Brugger et al. reference was filed on April 30, 1998 and issued on December 5, 2000 as U.S. Patent No. 6,156,419. The Brugger patent is assigned to ILFORD Imaging Switzerland GmbH as

is the present invention. At the time the invention was made (June 18, 1998), both Brugger and the present invention were both commonly owned by ILFORD Imaging Switzerland GmbH. Thus, the rejections of the claims as obvious over Brugger et al. should be withdrawn.

Since the Brugger reference is no longer considered prior art, the rejections of the claims in view of Brugger in combination with the secondary references are deemed moot.

In view of the foregoing arguments, Applicant submits that this application is now in condition for allowance. No new matter has been introduced by this Amendment. Reconsideration of this application and allowance of Claims 1-3, 5, 8, 9 and 11-21 are hereby requested. If a telephone interview would be useful to advance this case, then the Examiner is invited to telephone the undersigned.

#### 9. Small Entity Statement

- Statement(s) that this is a filing by a small entity under 37 CFR §§ 1.9 and 1/27 is(are) attached.
- Status as a small entity was claimed in prior application \_\_\_\_\_, from which benefit is being claimed for this application under 35 U.S.C. § \_\_\_\_ 119(e), \_\_\_\_ 120, \_\_\_\_ 121, \_\_\_\_ 365(c), and which status as a small entity is still proper and desired. A copy of the statement in the prior application is included.

**10. Filing Fee Calculation**

The filing fee has been calculated as follows:

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Basic fee for Other Than a Small entity		\$770
Total claims in excess of 20	(= 0) x \$18	0
Total independent claims in excess of 3	(= 0) x \$86	0
Multiple dependent claims	(= 0) \$290	0
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Basic Filing Fee Due:		\$ 770
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**11. Fee Payment Being Made at This Time**

<u>  X  </u>	Basic filing fee	\$ 770
<u>     </u>	Fee for recordation of assignment	\$ 0
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Total Fees Enclosed:		\$ 770
		=====

**12. Method of Payment of Fees**

      A check drawn on THE LAW OFFICES OF DARA L. ONOFRIO in the amount of \$\_\_\_\_\_.

  X   The Commissioner is hereby authorized to charge the fee in the amount of \$770.00 to Deposit Account No. 50-1541.

A duplicate copy of this Request is attached.

**13. Authorization to Charge Additional Fees and Instructions as to Overpayment**

The Commissioner is hereby authorized to charge any underpayment of fees required for the filing of this application, or credit any overpayment, to Deposit Account No. 50-1541.

The Commissioner is also hereby authorized to charge any under-payment of fees required to maintain the pendency of this application to Deposit Account No. 50-1541.

**14. Correspondence Address**

The power of attorney given to the attorney of record in the prior application is continued in this application. Please address all correspondence regarding this application to the undersigned attorney of record.

Respectfully submitted,

Attorney for Applicant

Dated: May 12, 2004

By:



Dara L. Onofrio  
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New York, NY 10010  
(212) 871-6112

**CERTIFICATE OF EXPRESS MAILING**

I hereby certify that this paper is being deposited with the United States Postal Service on the date shown below with sufficient postage as express mail No. EV 450792793 US in an envelope addressed to the:

Attention: BOX CPA  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dated: May 12, 2004

Dara L. Onofrio

Person mailing paper

Signature of person mailing  
paper

